

**REMARKS**

Claims 1-20 are pending in this application.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Paula in the March 6, 2007 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

**I. 35 U.S.C. §103(a) Rejection of Claims 1-6, 8-13, 17 and 18**

The Office Action rejects claims 1-6, 8-13, 17 and 18 under 35 U.S.C. §103(a) over Manly, U.S. Patent No. 3,714,636, in view of Ma et al. (Ma), U.S. Patent No. 6,909,805. The rejection is respectfully traversed.

(1) As discussed during the interview, Manly fails to disclose or suggest extracting only lesser portions of text from the machine generated text identified by detected annotations, and generating a summary including only the extracted lesser portions of text from the machine generated text of the document, as recited in independent claims 1 and 8. Manly discloses a manually operated typewriter that generates machine readable text on an original document (col. 1, lines 13-22). An author that proofreads the original document makes editing marks directly on the original document with a special pen (col. 1, lines 23-28). The editing marks of the special pen designate text of the original document to be deleted or removed (col. 1, lines 32-41), and instruct a machine to delete or remove the designated text (col. 1, lines 28-41). That is, the editing marks of the special pen instruct the machine to extract unwanted or undesirable portions of text from the original document. The deleted or removed (i.e., unwanted or undesirable) text is discarded and not included in the author's final draft. The extracted, deleted text is not included in any subsequently generated summary, as is the case in claims 1 and 8. Thus, claims 1 and 8 recite extracting portions of text identified by detected annotations to be included in a summary, while Manly teaches extracting portions of text identified by detected annotations to be discarded. During the interview, the Examiner

acknowledged that Manly teaches extracting only unwanted or undesirable portions of text from the original document, and that the extracted text is discarded so as not to be included in the author's final draft. However, the Examiner asserted during the interview that by indicating with the special pen portions of text to be extracted and discarded, the author would necessarily be at the same time designating text of the draft that would kept to be included in the final draft. The Examiner further asserted that the final draft corresponds to the claimed generated summary.

However, as clearly recited in claims 1 and 8, the claimed generated summary only includes those portions of the text from the machine generated text that are extracted because they are identified by detected annotations. Accordingly, any portions of the text in Manly not designated by the special pen are irrelevant to the affirmatively claimed features of this application. The not-designated portions of Manly are not extracted. The not-designated portions constitute the final document, which is the antithesis of a summary of a document. The combinations of features recited in claims 1 and 8 allow a user to affirmatively annotate important or relevant (e.g., desired) sections of text of an original document image to be subsequently compiled in a summary of the original document. Manly does not disclose these features or even the same concepts or goals obtained by the claimed features.

Manly discloses edit signals that instruct a machine to insert material that is separately generated by the original typewriter (col. 1, lines 47-50). However, the insert material ("insert record") is additional material that is "separately generated" (col. 1, lines 54-61) by the original typewriter to be inserted in the final record. Thus, the inserted, additional material is not designated by the editing marks of the special pen, and does not designate lesser portions of the text to be extracted. Moreover, the "insert record" is included in the

final document, not a summary of the document. Thus, Manly's insert material also does not correspond to the claimed extracted lesser portions.

Thus, Manly fails to disclose or suggest extracting only lesser portions of text from the machine generated text identified by detected annotations, and generating a summary including only the extracted lesser portions of text from the machine generated text of the document, as recited in independent claims 1 and 8.

(2) The Office Action acknowledges that Manly fails to disclose generating a summary that is a condensed version of the machine generated text of the original image of the document; the summary being generated as a separate electronic image document that is different from the original image, as recited in independent claims 1 and 8. However, the Office Action alleges that Ma discloses these features.

As discussed during the interview, Ma teaches that after extraction from the document image, all the printed text lines 52 may be saved into a memory (col. 7, lines 52-61). Ma does not disclose or suggest that the memory only includes the extracted lesser portions of text from the machine generated text of the document, or that the information stored in the memory is a condensed version of the machine generated text of the original image of the document. Instead, the entire original image of the document is saved into a memory (col. 7, lines 52-61). Accordingly, Ma is unable to allow only important or relevant sections of the original document image designated by the handwritten annotations to be compiled as a summary of the original image of the document, which is a benefit of the combinations of features recited in claims 1 and 8.

Further, Ma only teaches that the printed text lines 52 may be saved into a memory (col. 7, lines 52-61). Ma does not teach that the printed text lines 52 are subsequently output to form a separate electronic image document. Moreover, because all the printed text lines 52

(the entire original image of the document) are saved into a memory, as discussed above, Ma also fails to teach that any separate electronic image document would be different from the original image. Therefore, Ma fails to disclose or suggest the summary being generated as a separate electronic image document that is different from the original image, as recited in claims 1 and 8. Thus, Ma fails to disclose generating a summary that is a condensed version of the machine generated text of the original image of the document; the summary being generated as a separate electronic image document that is different from the original image, as recited in independent claims 1 and 8.

Although the instant Office Action states that the previous rejections are moot in light of the newly applied art, the Office Action continues to allege that Ma discloses these features. Thus, the instant Office Action fails to respond to the distinctions addressed in the November 18, 2006 Amendment with respect to the features of (2) above and Ma.

(3) One skilled in the art would not have been motivated at the time of the invention to combine the teachings of Manly and Ma to result in Applicants' claims. The Office Action alleges that the motivation to combine would be to increase "the flexibility of having multiple formats, and efficient separation of document data" (see Ma, col. 2, lines 30-37). However, the Office Action has not cited any evidence or support in either Ma or Manly that explains, discusses or suggests how the process of eliminating all the printed text lines from the scanned document image, irrespective of the location of handwritten annotations, as taught by Ma (see Fig. 1, steps 24 and 26; col. 3, line 67 to col. 4, line 5; col. 5, lines 64-66; col. 7, lines 53-61; Figs. 7 and 8), would make the proofreading process of Manly, in which only the undesirable text from the original document is deleted or removed, more efficient. Moreover, the additional "format" disclosed by Ma is not applicable to the proofreading process of

Manly because extracting all the printed text from the scanned document image defeats the purpose of proofreading a document to eliminate only undesirable text of a draft.

Although the Examiner concocts an alleged benefit of incorporating the process of Ma into the proofreading procedure of Manly, there is no evidence or support that explains, discusses or suggests how the two methods would be combined without defeating the disclosed purpose of Manly. Thus, the Examiner has provided no viable evidence to support the conclusion that one skilled in the art would have been motivated to combine Manly and Ma. Instead, the Office Action relies on impermissible hindsight using knowledge gleaned only from Applicants' disclosure (see MPEP §2145(X)(A)).

Thus, claims 1 and 8 are patentable over the combination of Manly and Ma. Because claims 2-6, 9-13, 17 and 18 incorporate the features of claims 1 and 8, these claims also are patentable over the combination. Therefore, it is respectfully requested that the rejection be withdrawn.

## **II. 35 U.S.C. §103(a) Rejections of Claims 7, 14-16, 19 and 20**

The Office Action rejects claims 7, 15 and 16 under 35 U.S.C. §103(a) over Manly in view of Bornstein et al. (Bornstein), U.S. Patent No. 5,867,164; rejects claim 14 under 35 U.S.C. §103(a) over Manly in view of Kupiec, U.S. Patent No. 6,533,822; and rejects claims 19 and 20 under 35 U.S.C. §103(a) over Manly in view of Lerner et al. (Lerner), U.S. Patent No. 6,859,909. The rejections are respectfully traversed.

First, the rejections are legally defective because, due to the fact that these claims depend from claim 1 or claim 8, the Patent Office cannot reject these claims without using at least the references that were used to reject claims 1 and 8. Thus, because the rejections do not rely on Ma (combined with Manly), the rejections are legally defective.

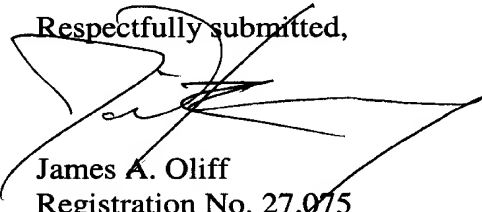
Second, each of Bornstein, Kupiec, and Lerner fails to overcome the deficiencies of Manly and Ma with respect to claims 1 and 8. Thus, claims 7, 14-16, 19 and 20, which incorporate the features of claims 1 and 8, also are patentable over any combination of the above references. Therefore, it is respectfully requested that the rejection be withdrawn.

### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
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